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OFFICE OF PETITIONS

In re Application of :
Steiger :
Application No. 09/336,462 :
Filed: June 18, 1999 :
Attorney Docket No. ICH 286 :
For: RECORDING SHEETS FOR INK JET :
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ON PETITION

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, or in the alternative, under 37 CFR 1.137(a), or in the alternative, under 37 CFR 1.137(b), to revive the above-identified application. All petitions were filed in the same paper on May 12, 2004. The Office apologizes for the delay in addressing the petitions.

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is **DISMISSED**.

The petition under 1.137(a) to revive the application is **DISMISSED**.

The petition under 37 CFR 1.137(b) to revive the application is **GRANTED**.

The above-identified application became abandoned for failure to properly reply to the final Office action, mailed August 12, 2003. Petitioner filed an amendment after final and a request for a two month extension of time and required fee on January 14, 2004 (certificate of mailing date January 12, 2004). The amendment after final failed to place the above-identified application in *prima facie* condition for allowance, as stated in the February 23, 2004 Advisory Action. The application became abandoned on January 13, 2004. The filing of the instant petitions precedes the mailing of a Notice of Abandonment.

PETITION UNDER 37 CFR 1.181

Petitioner requests that the holding of abandonment be withdrawn. Petitioner argues that applicant acted with promptness, diligence, and good faith in timely filing the January 14, 2004 (certificate of mailing date January 12, 2004) amendment. Petitioner asserts that because the February 23, 2004 Advisory Action was mailed after the expiration of the extendable six (6) month deadline for response to the August 12, 2003 final Office action, that it was not possible for petitioner to timely respond.

Petitioner is informed that the application became abandoned due to applicant's failure to submit a proper reply to the August 12, 2003 final Office action, **not** for failure to respond to the February 23, 2004 Advisory Action. Filing an amendment after final that failed to place the application in *prima facie* condition for allowance did not toll the period for reply to the August 12, 2003 final Office action or shift the burden of prosecution on the Office.

The application is properly held abandoned. The petition under 37 CFR 1.181 to withdraw the holding of abandonment is **dismissed**.

PETITION UNDER 37 CFR 1.137(A)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee as set forth in § 1.17(l);
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

This petition does not satisfy requirement (3).

Regarding (3), the showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term 'unavoidable' "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

In the instant case, petitioner has failed to provide adequate evidence that the delay was unavoidable. Petitioner is reminded that after a final action, there are only five possible replies: (1) a Notice of Appeal, (2) a continuing application, (3) a 37 CFR 1.129(a) submission, if appropriate, (4) an amendment after final that makes the case ready for issuance or (5) a RCE. To be a proper reply, an amendment after final must eliminate all of the Examiner's objections and rejections, and thus place the case in *prima facie* condition for allowance.

Petitioner's amendment after final failed to eliminate all of the Examiner's objections and rejections. The rules of practice are clear that prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last Office action, or refusal to admit the same, shall not operate to save the application from abandonment. "[T]he admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135." See 37 CFR 1.116(a).

Petitioner's failure to appreciate that the filing of a proposed amendment under 37 CFR 1.116 on January 14, 2004 (certificate of mailing date January 12, 2004) did not relieve petitioner of the

above-identified application is unfortunate, but it is not unavoidable delay. The abandonment of an application subject to a final Office action is not “unavoidable” within the meaning of 35 USC 133 and 37 CFR 1.137(a) in the situation in which the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. At 53162, 1203 Off. Gaz. Pat. Office at 89 (response to comment 66).

Petitioner is reminded that an Advisory Action does not start a new period for response. The application became abandoned because petitioner did not submit a proper reply to the final Office action.

The petition under 37 CFR 1.137(a) is **dismissed**. Pursuant to petitioner’s authorization, the \$110.00 fee for filing a petition under 37 CFR 1.137(a) will be charged to deposit account no. 50-1541.

PETITION UNDER 37 CFR 1.137(B)

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

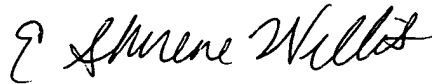
Applicant has submitted a reply in the form of a CPA and preliminary amendment. Effective July 14, 2003, CPA practice was eliminated as to utility and plant applications. Any request for a CPA filed on or after July 14, 2003 in a utility or plant application is improper, regardless of the filing date of the utility or plant application in which the CPA is filed. An improper CPA is treated as a RCE. Since the improper CPA in this case was filed with a preliminary amendment and the

January 14, 2004 (certificate of mailing date January 12, 2004) after final amendment could be a proper submission, the improper CPA will be treated as a proper RCE. Petitioner has submitted an acceptable statement of the unintentional nature of the delay in responding to the August 12, 2003 final Office action and pursuant to petitioner's authorization, the Office will charge the petition fee of \$1,330.00 to deposit account no. 50-1541 shortly.

The petition under 37 CFR 1.137(b) is **granted**.

After the mailing of this decision the application will be forwarded to Technology Center 1700 for further examination.

Telephone inquiries pertaining to this matter may be directed to the undersigned at (571) 272-3230.

A handwritten signature in black ink, appearing to read "E. Shirene Willis". The signature is fluid and cursive, with a large initial "E" and a stylized "S" for "Shirene".

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions